

**In the Drawings**

As correctly noted by the Examiner, Fig. 16A was previously labeled as "Prior Art." Accordingly, Fig. 16A is amended to remove the label "Prior Art" from Fig. 16A. A Replacement Sheet is provided as Attachment A including amended Fig. 16A.

## REMARKS

This Amendment responds to the Office Action mailed February 1, 2006, and is filed contemporaneously with a request for a three-month extension of time. Claims 1-36 are pending in the application for reconsideration.

Applicants wish to express their appreciation to the Examiner for indicating that claim 26 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

### *Summary of the Office Action*

In the Office Action, the Examiner objected to the drawings, noting that Fig. 16A contains a label "Prior Art" that is incorrect. Also in the Office Action, claims 1-4, 14-17, 21-23, 27-32, 35, and 36 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,891,095 to Eggers et al. ("Eggers"), claims 5-13 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eggers in view of U.S. Patent No. 6,106,519 to Long et al. ("Long"), claims 18-20 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eggers in view of U.S. Patent No. 6,413,255 to Stern ("Stern"), and claims 24 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eggers in view of U.S. Patent No. 6,228,081 to Goble et al. ("Goble"). Finally, the Examiner objected to claim 26 as being dependent upon a rejected base claim, but stated that the claim would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claim. The objections and rejections are respectfully traversed based upon the foregoing amendment to the Drawings and the following remarks.

### *Response to the objection to the Drawings*

In response to the Office Action, Applicants have submitted herewith a Replacement Sheet for Fig. 16A which removes the erroneous label "Prior Art" in accordance with the Examiner's suggestion. Consequently, Applicants respectfully request the withdrawal of this objection.

***Response to the rejections under 35 U.S.C. § 102(b)***

In response to the Examiner's rejection of claims 1-4, 14-17, 21-23, 27-32, 35, and 36 under 35 U.S.C. § 102(b) as being anticipated by Eggers, Applicants traverse this rejection as follows.

Claim 1 recites: "a return path element which interacts with a second portion of said patient during said first electrosurgical procedure . . . and wherein said return path element comprises *a first dielectric component which interfaces with said patient.*" By utilizing a first dielectric component, the present invention "effectively defines or is at least part of a capacitor in the return path to the generator, such that the energy from the patient is at least initially returned to the generator via electrical fields versus conduction." US 2004/0116919, Para 0024.

The Examiner states that Eggers discloses "[a] first dielectric component (18) interfaces with the patient and surrounds the return element along a substantial portion of its length." However, in contrast to the claim 1, Eggers teaches that component 18 is an electrically insulating jacket "typically formed as one or more electrically insulative sheaths or coatings, such as polytetrafluoroethylene, polyimide, and the like" Eggers at col. 11, ll. 4-5 and ll. 40-42. Thus it is clear that component 18 is not a dielectric material as recited in the claims of the present invention or as asserted by the Examiner. Rather, component 18 of Eggers is described as an electrically insulating material. As such, component 18 of Eggers will not allow the energy from the patient to initially return to the generator via electric fields versus conduction. To anticipate under 35 U.S.C. § 102(b) a reference must disclose each and every limitation recited in the claims. Since Eggers fails to disclose the recited first dielectric component, Eggers fails to anticipate claim 1 of the present invention. Accordingly, Applicants respectfully request the withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(b).

Further, since claims 2-4, 14-17, 21-23, 27-32, 35, and 36 each depend from claim 1, Applicants also respectfully request withdrawal of the rejections of claims 2-4, 14-17,

21-23, 27-32, 35, and 36 under 35 U.S.C. § 102(b) for at least the same reasons as stated for claim 1.

*Response to the rejections of claims 5-13 and 34 under 35 U.S.C. § 103(b)*

The Examiner rejected claims 5-13 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Eggers in view of Long. In doing so, the Examiner correctly states that Eggers fails to disclose a specific material that has a dielectric product as set forth in these claims. To cure this deficiency of Eggers, the Examiner cites Long as providing a teaching to use Barium Titante as a dielectric material. Moreover, the Examiner states that “[I]t would have been an obvious design consideration for one of ordinary skill in the art, particularly in view of the teaching of Long et al.” Office Action, dated February 1, 2006, page 5.

However, as discussed above, Applicants submit that Eggers fails to disclose a first dielectric component recited in claim 1 from which claims 5-13 and 34 depend. As noted above, identified component 18 of Eggers is an electrically insulating jacket, not a dielectric component. Long fails to cure this deficiency in Eggers.

Additionally, there is no motivation to combine Long with Eggers as asserted in the Office Action. While Eggers discloses the use of ceramics for other components, Eggers specifically discloses that component 18 is “formed as one or more electrically insulative sheaths or coatings, such as polytetrafluoroethylene, polyimide, and the like” Eggers at col. 11, 40-42. Both polytetrafluoroethylene, polyimide are polymers using carbon-carbon bonds and, thus, are not ceramics. The teaching of “and the like” in Eggers with respect to component 18 is therefore limited to similar polymers using carbon-carbon bonds. The barium titanate disclosed in Long is a ceramic and not a polymer using carbon-carbon bonds. Thus, the disclosure in Eggers concerning the material of component 18 teaches away from the use of ceramics for this component. Consequently, one of skill in the art at the time would not understand this teaching to encompass a ceramic material. Moreover, one of skill in the art would not consider the

use of the ceramic materials disclosed in Long to be an obvious design consideration for component 18 in Eggers since that use would require disregarding the teachings of Eggers. Accordingly, Applicants respectfully submit that there is no proper motivation to combine the teachings of Long with those of Eggers. Thus, Long fails to cure the deficiencies of Eggers, and therefore, Applicants respectfully request the withdrawal of the rejection of claims 5-13 and 34 under 35 U.S.C. § 103(a).

*Response to the rejections of claims 18-20 and 25 under 35 U.S.C. § 103(b)*

The Examiner also rejected claims 18-20 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Eggers in view of Stern. In doing so, the Examiner correctly states that Eggers fails to disclose energy being returned to the generator through the dielectric material as recited in claims 18-20. In order to cure the deficiency of Eggers, the Examiner relies upon the teachings of Stern of providing both the active and return electrodes with a dielectric coating to provide a more uniform distribution of energy across the electrode surface.

Applicants respectfully traverse this rejection for the reasons discussed above with respect to the base claim 1, and because the teachings of Eggers and Stern in fact teach away from the asserted combination. Specifically, Eggers teaches using a conductive return electrode in "a surrounding electrically conducting liquid 50 (e.g., isotonic saline)." Eggers '095, col. 11, ll. 32-33. In contrast, Stern states, "[a]nother advantage of the use of a dielectric coating is the minimization of the need to use a conductive fluid (e.g. saline solution) to conduct RF energy." Stern '255, col. 9, ll. 64-66. Thus, Stern specifically teaches using a dielectric coating for the transfer of energy in place of the conductive fluid used in Eggers. As Stern teaches a very different device and method than that disclosed in Eggers, there is no motivation to combine the dielectric coating of Stern with the perforated shield of Eggers which is provided to allow the electrically conductive liquid to contact an electrically conductive layer. Thus, Stern specifically teaches away from the device disclosed in Eggers. Accordingly, Applicants respectfully

submit there is no proper motivation to combine the teachings of Stern with those of Eggers.

For these reasons, Stern fails to cure the deficiencies of Eggers. As such, Applicants respectfully request the withdrawal of the rejection of claims 18-20 and 25 under 35 U.S.C. § 103(a).

*Response to the rejections of claims 24 and 33 under 35 U.S.C. § 103(b)*

The Examiner also rejected claims 24 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Eggers in view of Goble. The Examiner correctly states that Eggers fails to disclose the use of a capacitor or a shunt circuit in the return path of the electrosurgical device. To cure this deficiency the Examiner combines Eggers with the teachings of Goble to provide Eggers with “a capacitor and/or shunt circuit in the return path to better control the delivery of energy to/from the generator.”

While Applicants disagree that Goble discloses the subject matter recited in claims 24 and 33, Applicants respectfully traverse this rejection for the reasons discussed above with respect to the base claim 1. Specifically, Goble does not cure the deficiency in Eggers of failing to disclose the first dielectric component recited in claim 1 from which claims 24 and 33 depend. Since the combination of Eggers and Goble fails to disclose all elements in claims 24 and 33, Applicants respectfully submit that these claims are allowable over the combination. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 24 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Eggers in view of Goble.

*Response to the Objection to Claim 26*

In view of the foregoing remarks with respect to claim 1, Applicants respectfully submit that the base claims upon which claim 26 depends are allowable. Accordingly, Applicants respectfully request withdrawal of the objection to claim 26.

Conclusion

In view of the above amendment and remarks, Applicant respectfully requests that all objections and rejections be withdrawn and that a notice of allowance be forthcoming. The Examiner is invited to contact the undersigned for any reason related to the advancement of this case.

Respectfully submitted,

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## ATTACHMENT A

A drawing Replacement Sheet containing figures 16A and 16B is attached hereafter.